

## **REMARKS**

Applicants' undersigned attorneys, Richard Moss and Leslie Nguyen, would like to thank Supervisory Examiner T.C. Patel for the courtesies extended during the telephonic interview conducted on October 5, 2006 regarding the Office Action mailed July 7, 2006. An Interview Summary is set forth below followed by a detailed response to the objections and rejections raised in the Office Action.

### **I. Interview Summary**

During the telephonic interview conducted on October 5<sup>th</sup>, 2006, Applicants' attorneys, Richard Moss and Leslie Nguyen, and Supervisory Patent Examiner Patel first discussed, in general terms, Applicants' invention as set forth in detail in the present application. The focus of the interview then turned to (i) the objection to the drawings under 37 CFR 1.83(a) as allegedly failing to show the claimed interchangeability of the connector shell, (ii) the rejection of claims 1, 3 and 12-17 under 35 U.S.C. § 112, first paragraph, as allegedly failing to describe the claimed interchangeability of the connector shell, (iii) the rejection of claims 1, 3 and 12-17 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,558,178 to Nakamura (hereinafter "Nakamura") and (iv) the rejection of claims 4-9 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,890,930 to Gerow (hereinafter "Gerow") in view of U.S. Patent No. 4,355,855 to Rebikoff (hereinafter "Rebikoff"). During the interview, Applicants' position traversing the foregoing objections and rejections was presented and is summarized below.

Regarding the Examiner's objection to the drawings under 37 CFR 1.83(a) and rejection of claims 1, 3 and 12-17 under 35 U.S.C. § 112, first paragraph, Applicants' attorneys directed the Supervisory Patent Examiner's attention to the application specification as filed

which provides support for the claimed interchangeability of the connector shell, particularly paragraphs [0010] and [0012], Figs. 5 and 6 of the drawings, and original claim 2.

Regarding the Examiner's rejection of claims 1, 3 and 12-17 under 35 U.S.C. §102(e) as being anticipated by Nakamura, Applicants' attorneys directed the Supervisory Patent Examiner's attention to the differences in construction and arrangement between the device claimed in the present application and the device disclosed in Nakamura (as readily apparent from a comparison of the application drawings against the Nakamura drawings). Applicants' attorneys then, with reference to the drawings, explained that Nakamura nowhere teaches or suggests the contact device as affirmatively claimed in independent claims 1 and 17 of the present application comprising the interchangeable connector shell with its plug receiving terminal socket including one or more contact tabs in electrical contact with one or more contact pins extending through the insulator.

Regarding the Examiner's rejection of claims 4-9 and 11 under 35 U.S.C. §103(a) as being unpatentable over Gerow in view of Rebikoff, Applicants' attorneys explained that neither Gerow nor Rebikoff cured the severe deficiencies of Nakamura. Gerow and Rebikoff, alone or in combination, do not teach or suggest the contact device according to the present invention as affirmatively claimed in independent claims 4 of the present application comprising the interchangeable connector shell with its plug receiving terminal socket including one or more contact tabs in electrical contact with one or more contact pins extending through the insulator.

The Supervisory Patent Examiner was favorably receptive to and did not dispute Applicants' arguments presented during the telephonic interview traversing the objections and rejections recited in the Office Action. Indeed, in a follow-up telephone call on October 13, 2006, the Supervisory Patent Examiner indicated that he had recommended to the Examiner that

she reevaluate the objections and rejections raised in the Office Action in view of the arguments presented by Applicants' attorneys, and that if any further objections/rejections are to be made that they be based on a search for new prior art. Supervisory Patent Examiner Patel also recommended that Applicants' attorneys prepare a formal response to the outstanding Office Action including the arguments presented during the October 5, 2006 telephonic interview. This Response is being submitted in compliance with the Supervisory Patent Examiner's recommendation.

## **II. Response**

Claims 1 and 3-17 are pending in this application. The previous allowance of claim 16 was withdrawn. Claims 1, 3-9 and 11-17 stand rejected. Claim 10 was objected to as being dependent upon a rejected base claim but the Examiner indicated that the claim would be allowable if rewritten in independent form. In view of the telephonic interview with Supervisory Patent Examiner Patel and the following remarks, reconsideration and allowance of this application is respectfully requested.

The Examiner objected to the drawings under 37 CFR 1.83(a) as allegedly failing to show the claimed interchangeability of the connector shell. Claims 1, 3 and 12-17 were also rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to describe the claimed interchangeability of the connector shell. Applicants respectfully submit that paragraphs [0010] and [0012] of the specification, Figs. 5 and 6 of the drawings, and claim 2 of the present application as filed provide support for the claimed interchangeability of the connector shell.

Paragraph [0010] describes a connector shell according to one embodiment of the present invention wherein the connector shell is "one of a set of interchangeable connector shells, each having a different configuration for use with a corresponding connecting cable."

Paragraph [0012] describes a connector shell according to one embodiment of the present invention wherein the connector shell can be fitted onto an insulator for connection to various kinds of connecting cables. There is no need to maintain an inventory of different connector versions because of the interchangeability of the connector shell.

Fig. 5 shows a terminal socket with a two-pin configuration joined to the connector shell while Fig. 6 shows a terminal socket with a three-pin configuration joined to the connector shell. Because the connector shell can accommodate alternative terminal ends, Figs. 5 and 6 support interchangeability of the connector shell. Furthermore, the use of screws 9, 10 show that the connector shell is removable, thus enabling the interchangeability of the connector shell.

Claim 2 as filed recited that the connector shell is one of a set of interchangeable connector shells each having a different configuration suitable for connection of a corresponding connector member of said connecting cable.

The Federal Circuit has instructed that “any party making the assertion that a U.S. patent specification or claims fails, for one reason or another, to comply with Section 112 bears the burden of persuasion in showing said lack of compliance.” *Fiers v. Revel v. Sugano*, 25 U.S.P.Q.2d 1601, 1607 (Fed. Cir. 1993) (quoting *In re Marzocchi*, 169 U.S.P.Q. 367, 369 (C.C.P.A. 1971); *Weil v. Fritz*, 202 U.S.P.Q. 447, 450 (C.C.P.A. 1979)). *See also In re Angstadt*, 190 U.S.P.Q. 214, 219 (C.C.P.A.) (citing *In re Armbruster*, 185 U.S.P.Q. 152 (C.C.P.A. 1975)) (“[T]he PTO has the burden of giving reasons, supported by the record as a whole, why the specification is not enabling...”). Applicants respectfully submit that, in view of the foregoing, the Examiner has not and cannot meet this burden. As discussed with Supervisory Patent

Examiner Patel, it is clear from the present application as filed that Applicants had possession of the claimed invention in accord with 35 U.S.C. § 112.

Accordingly, it is submitted that (i) the drawings do not run afoul of 37 CFR 1.83(a) as they show every feature of the invention specified in the claims and (ii) claims 1, 3 and 12-17 do not run afoul of 35 U.S.C. § 112, first paragraph as such claims are fully supported by the specification. Notice to this effect is earnestly solicited.

Turning now to the substantive claim rejections, independent claims 1 and 17 and dependent claims 3 and 12-16 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nakamura. Applicants respectfully traverse the foregoing claim rejections.

As set forth in detail in the present application, as discussed during the telephonic interview with Supervisory Patent Examiner Patel and as described in previous submissions, Applicants' invention is directed to a new pressure-tight contact device especially of the type employed in connection with a pressure-tight encapsulated electric motor for driving, for example, a compressor used in a vehicle air suspension system. The inventive contact device includes an insulator extending through and sealed relative to a pressure-tight housing. One or more contact pins (electrically connected to the motor, for example) are retained in and extend through the insulator and are sealed relative to the insulator. A connector shell is positioned on the insulator, sealed relative to the insulator, and affixed to the insulator or the housing. The connector shell includes a terminal receptacle or socket for engaging a separate mating connector attached to an electric connecting cable (i.e., a plug). One or more contact tabs are disposed in the connector shell in secure electrical contact with the contact pin(s) and extend into the terminal socket to engage the mating connector (plug).

The connector shell can be one of a set of interchangeable connector shells each having a different configuration for mating with a corresponding plug. In essence, the connector shell provides a pressure-tight, interchangeable contact assembly interposed between contact pin (e.g., leading to the motor or other encapsulated device) and plug (e.g., leading to current supply lines or further signal lines) -- as explained below, such a novel construction and arrangement is not described or even suggested in any of the references cited by the Examiner in the Office Action.

Nakamura describes embodiments of a waterproof connector 50 (see Fig. 9) having a small size due to the reduction of surplus space. Connector 50 has two open ends, one of which (the anterior end) forms a hood 53 for housing a mating connector 30. Connector 50 also has an inner housing 52 and an outer housing 51. A sealing ring 61 is fitted into a groove 55A formed in a wall 53A of the posterior end of the outer housing. As a result, the sealing ring can be provided without increasing the outer circumference of a fitting space 60 (see Fig. 8). Furthermore, the fitting space has no surplus space corresponding to the thickness of the sealing ring.

As discussed with Supervisory Patent Examiner Patel, Nakamura does not disclose, suggest or yield the present invention as claimed in independent claims 1 and 17 -- significant differences in construction and arrangement exist between the device claimed in the present application and the device disclosed in Nakamura that warrant the immediate withdrawal of the claim rejections on anticipation grounds. Nakamura does not disclose each element of the rejected claims, and accordingly, the Examiner has not made out a *prima facie* case of anticipation.

Nakamura nowhere teaches or suggests the contact device according to the present invention as affirmatively claimed in independent claims 1 and 17 of the present application comprising the interchangeable connector shell with its plug receiving terminal socket including one or more contact tabs in electrical contact with one or more contact pins extending through the insulator. It is respectfully submitted that the Examiner misinterprets Nakamura as disclosing the terminal socket including a contact tab according to the present invention. Barrel 44 for connecting a wire and distal tab 42 as elements of the Nakamura plug 30 are not relevant to the contact tab of the present invention which forms part of the interchangeable connector shell's terminal socket for receiving a plug.

Furthermore, contrary to the Examiner's interpretation of Nakamura, element 52 of Nakamura does not correspond to the insulator according to the present claimed invention in which the contact pin(s) is(are) retained. Even assuming *arguendo* that element 52 is an insulator of the general type employed in the present invention under consideration, element 52 does not extend through the housing as affirmatively required in claims 1 and 17 of the present application. Extension of the insulator through the housing in accordance with the present invention facilitates the affixation and sealing of the connector shell relative to the insulator – contributing to the pressure-tight characteristic of the claimed inventive device.

Accordingly, as discussed with Supervisory Patent Examiner Patel, claims 1 and 17 of the present application recite features and structure nowhere found in the Nakamura reference, and, thus, Nakamura cannot anticipate claims 1 and 17.

The Federal Circuit has instructed that anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *See W.L. Gore & Assocs. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 841 (1984);

see also *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (requiring that the prior art reference disclose each element of the claimed invention arranged as in the claim). Considering that the device of the present invention as claimed in independent claims 1 and 17 differ in structure and arrangement from the device disclosed in Nakamura, as provided above, it is respectfully submitted that the Examiner has not made a *prima facie* case of anticipation, and that claims 1 and 17 are thus patentable over Nakamura. Notice to this effect is earnestly requested.

Furthermore, given the fact that there is no disclosure in Nakamura of any details whatsoever concerning an interchangeable connector shell with its plug receiving terminal socket including one or more contact tabs in electrical contact with one or more contact pins extending through an insulator, Applicants respectfully submit that, absent the present application for patent, the Examiner would not have perceived a disclosure of the device of the present invention in Nakamura. By taking in hindsight knowledge of the device according to the present invention and attributing elements thereof to Nakamura to fashion claim rejections under 35 U.S.C.

§ 102(e) when the cited art does not contain or support the knowledge, it is respectfully submitted that the Examiner is impermissibly using the claimed invention as a blueprint for its own reconstruction. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made. See e.g. *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 547 (Fed. Cir. 1985), *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). Accordingly, Applicants respectfully dispute the Examiner's contention that Nakamura teaches the present invention as affirmatively claimed in independent claims 1 and 17.



It is further submitted that dependent claims 3 and 12-16 are also allowable by reason of their various dependencies from independent claim 1, as well as for the additional features and structure recited therein. Notice to this effect is also earnestly requested.

Independent claims 4 and dependent claims 5-9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gerow in view of Rebikoff.

Gerow describes embodiments of a field-replaceable connector including a shell 20, a main insulator 22 within the shell and main contacts 24 in the main insulator having socket front ends 30. An insert module 32 includes an insulator 36 and contacts 38 with pin-type ends. The insert module is inserted into the shell of the connector to mate with the main contacts. If the front ends 40 of the insert contacts are damaged, the connector can be repaired in the field by merely removing the first module and replacing it with another module. A connector system according to Gerow includes a second field replaceable connector which is mateable with the first one, and which is of corresponding construction.

Gerow does not disclose or yield the present invention as claimed. Gerow nowhere teaches or suggests the contact device according to the present invention as affirmatively claimed in independent claim 4 of the present application comprising the connector shell and terminal socket including one or more contact tabs in elastic and electrical contact with one or more contact pins extending through the insulator. Indeed, the Examiner acknowledged as much when she previously allowed claims 4. Applicants respectfully request the Examiner to reconcile her previous allowance of claim 4 in view of Gerow (Gerow being known to the Examiner since the first Office Action on the merits in this case), with her new-found reliance on Gerow as a principal reference in the rejection of claims 4.

Rebikoff describes embodiments of a waterproof, electrical connector with a bulkhead mounted receptacle having an O-ring compressed between the bulkhead and the mating surface of the receptacle shell. An O-ring 56 is provided about a pin contact 54 for mating with a rubber insulator 48. Applicants respectfully submit that Rebikoff does not overcome the severe deficiencies of Gerow. Indeed, Rebikoff is not directed at the present invention. Rebikoff is primarily concerned with a connector that maintains watertight integrity at increased pressure. Rebikoff nowhere teaches or suggests the contact device according to the present invention comprising the connector shell and terminal socket including one or more contact tabs in elastic and electrical contact with one or more contact pins extending through the insulator. Thus, as discussed with Supervisory Patent Examiner Patel, claim 4 is respectfully asserted as allowable over the cited combination of references. Notice to this effect is earnestly requested.

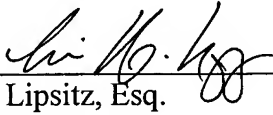
It is further submitted that dependent claims 5-9 and 11 are also allowable by reason of their various dependencies from independent claim 4, as well as for the additional features and structure recited therein. Notice to this effect is also earnestly requested.

Dependent claim 10 was objected to as being dependent upon a rejected base claim, but the Examiner indicated that the claim would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As discussed above, independent claim 4, from which claim 10 depends, is allowable over the cited combination of references. As such, dependent claim 4 is allowable by reason of its dependency from independent claim 4, as well as for the additional features and structure recited therein. Notice to this effect is earnestly requested.

On the basis of the foregoing remarks, Applicants respectfully submit that this application is in condition for immediate allowance, and notice to this effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned attorneys at the telephone number set forth below if it will advance the prosecution of this case.

A check in the amount of \$120.00 covering the fee for the Petition for a One Month Extension of Time submitted herewith is enclosed. Please charge any fee deficiency to Deposit Account No. 50-0540.

Respectfully submitted,

  
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